



UNDER SECRETARY OF COMMERCE FOR INTELLECTUAL PROPERTY  
AND DIRECTOR OF THE UNITED STATES PATENT AND TRADEMARK OFFICE  
WASHINGTON, D.C. 20231  
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DEC - 6 2001

#16

In re Application of  
McCafferty, et al  
Serial No.: 09/417,478  
Filed: October 13, 1999  
Attorney Docket No.: 13839-00010(28111-32729B)

This is in response to applicants' "RESPONSE TO COMMUNICATION FROM COMMISSIONER AND PETITION UNDER 37 C.F.R. 1.181 AND 1.183" filed October 5, 2001, requesting withdrawal of the requirements for a Sequence Listing.

The petition was filed in response to a communication from the examiner mailed July 30, 2001, in which the examiner stated that the instant application failed to comply with the requirements of 37 C.F.R. 1.821-1.825. Specifically, applicant failed to provide a computer readable form (CRF) and a paper copy of the sequence listing along with a statement that the contents of the paper copy and CRF are the same and that no new matter has been added.

A review of the application history shows that instant application was filed as a divisional application of U.S. patent application Serial No. 08/484,893, filed June 7, 1995, which was a continuation of U.S. patent application Serial No. 07/971,857, filed January 8, 1993, which was the U.S. national stage of PCT/GB91/01134, filed July 10, 1991. The exemption from filing a sequence listing is limited to the national stage filing under 37 C.F.R. 371. Therefore, the exemption only applied to 07/971,857 application which is the national stage of PCT/GB91/01134 which was filed before the implementation of equivalent PCT Administrative Instructions, Annex C. Divisional application 08/484,893 and instant application are treated as new applications and thus are required to comply with the sequence rules.

Applicants state that compliance with 37 C.F.R. 1.821-1.825 may be waived under "exceptional circumstances" and cites MPEP2421.01. Applicants submit that requiring the present application to comply with the sequence listing rules would place undue hardship on the applicants because

the sequence data found in the present application is currently not available in CRF. Applicants further state that it would require a huge expenditure of time and expense to manually enter and format numerous peptide and nucleotide sequences without providing commensurate benefit to either the USPTO or the public especially in view of the fact that none of the sequence are being claimed. Finally, applicants submit that amending the specification and the drawings to recite SEQ ID. NOs. would add to the examiner's burden in examining the instant application.

Applicants' arguments have been carefully considered and found unpersuasive for the following reasons:

1) With regard to the huge expenditure of time and expense to manually enter and format numerous peptide and nucleotide sequences, applicants should note that the submission of the CRF increases accuracy of the search and reproduction, and reduces cost. Applicants can download PatentIn 3.1 software program from USPTO website, for assistance please call General Information Service at (800) 786-9199 or (703) 308-4357 or e-mail to [patin3help@uspto.gov](mailto:patin3help@uspto.gov). To reduce errored sequence listing, please use the CHECKER VERSION 3.0 Program which can be downloaded from the USPTO website at: <http://www.uspto.gov/web/offices/pac/checker>.

2) With regard to the burden of filing a second "substitute specification", applicants please note that compliance with the sequence rules does not necessarily result in the need of filing a substitute specification.

For sequences found in the specification, SEQ ID Nos need to be inserted for those sequences. For Figures, the SEQ ID Nos need to be inserted to both drawings and corresponding Brief Description of Drawings of those sequences. In addition, a sequence listing needs to be added by amendment to the specification.

As to the claims, since no sequences are claimed, no amendment to the claims is required.

Applicants' statement of "....excessively time consuming, prohibitively expensive..." is noted. The amendments may be complex and lengthy, it is not likely to be excessively expensive.

3) With regard to the statement of " ...without commensurate benefit to the PTO or the public..." , compliance with sequence rules reduces the difficulties in analysis and searching within the Office and outside the Office. Once the patent issued, the description must be sufficient to aid in the resolution of questions of infringement. As a general rule, the more standardized information that is provided for a particular sequence, the better the examiner or public will be able to compare the identity and characteristics of the sequence with prior art.

Accordingly, the petition is **DENIED**.

Applicant is required to comply with the requirements of 37 C.F.R. 1.821-1.825 as set forth in paper no. 14 mailed July 30, 2001. It is noted that applicants requesting for an extension of time for two-months if Petitioners are mistaken. The extension of time for two-months is Granted.

A handwritten signature in black ink, appearing to read "Bruce Kisliuk". The signature is fluid and cursive, with the first name "Bruce" and last name "Kisliuk" clearly distinguishable.

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